

II. REMARKS:

A. Status of the Claims

Claims 1-2 were originally filed with the case. Claims 3-18 have been added herein. Support for the added claims may be found at page 4, lines 31-34 (claim 3); page 7, line 5 to page 9, line 12 (claims 4-15); and page 4, lines 36-37 (claims 16-18). No claims are amended or cancelled herein. Claims 1-18 are pending.

B. The Claims are Patentable Over Co-Pending Application No. 10/867,289

The Action provisionally rejects claims 1-2 over co-pending application number 10/867,289 (the '289 application). The Action states that, although the conflicting claims are not identical to the rejected claims, they are not patentably distinct from each other due to the presence of the term "comprising" in the currently pending claims. Applicants respectfully traverse.

The present invention is directed to the use of glucocorticoids, either alone or in combination with anecortave acetate, to treat pathologic ocular angiogenesis and any associated edema. Glucocorticoids are members of the family of compounds called corticosteroids, or steroids. The '289 application, on the other hand, is directed to the use of non-steroidal anti-inflammatory agents, in combination with anecortave acetate, to treat pathologic ocular angiogenesis and any associated edema. Thus, the two applications are directed to vastly differing subject matter.

Nevertheless, applicants agree to timely file a terminal disclaimer in compliance with 37 C.F.R. §1.321(c) to overcome the rejection once a notice of allowable subject matter is received.

C. **The Claims are Patentable Over Clark**

The Action rejects claims 1-2 as being unpatentable over Clark (U.S. Patent No. 5,770,592; the '592 patent). The '592 patent is said to teach a method of treating ocular neovascularization disorders using anecortave acetate. That Action asserts that the edema condition associated with ocular angiogenesis is inherently treated in the same method. Applicants respectfully traverse.

The present invention is directed to the use of glucocorticoids, alone or in combination with anecortave acetate to treat ocular neovascularization disorders associated with certain diseases or conditions. Anecortave acetate is not a glucocorticoid. Rather, it is a synthetic analog of cortisol acetate, known as a cortisone, that is devoid of glucocorticoid activity. Clark AF. AL-3789: a novel ophthalmic angiostatic steroid. *Exp Opin Invest Drugs*. 1997;6:1867-77. According to the currently pending claims, anecortave acetate is only used in combination with glucocorticoids in the methods of the invention. The '592 patent does not discuss the use of anecortave acetate in combination with any other agent to treat ocular neovascularization, rather it discloses only the use of anecortave acetate alone for the treatment of ocular neovascularization.

For a prior art reference to render a claim anticipated, that reference must set forth every element in the claim, either expressly or inherently. *Verdegaal Bros., Inc. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051 (Fed. Cir. 1987) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548, 220 U.S.P.Q. 193, 198 (Fed. Cir. 1983)). In other words, to support a rejection under section 102, a reference must show **all** features of the rejected claim(s). *Minnesota Mining & Mfg. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d

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1559, 1569, 24 USPQ2d 1321 (Fed. Cir. 1992). The Federal Circuit has stated that "absence of a claim element from a prior art reference negates anticipation." *Atlas Powder Co. v. E.I. du Pont de Nemours & Co.*, 224 U.S.P.Q. 409 (Fed. Cir. 1984). Since the '592 patent fails to teach the use of anecortave acetate in any combination, much less in combination with glucocorticoids, for the treatment of pathologic ocular angiogenesis and any associated edema, it cannot anticipate the claimed invention.

In light of the foregoing arguments, Applicants respectfully request that the anticipation rejection based on the '592 patent be withdrawn.

D. Conclusion

This is submitted to be a complete response to the outstanding Action. Based on the foregoing arguments, the claims are believed to be in condition for allowance; a notice of allowability is therefore respectfully requested.

The Examiner is invited to contact the undersigned attorney at (817) 551-4321 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,



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